

RESPONSE TO RESTRICTION REQUIREMENT

Page 9

Serial No.: 10/539,765

Dkt: 1662.004US2

Filed: February 8, 2006

Title: METHODS AND COMPOSITIONS FOR SELECTIVELY ENRICHING MICROBES**REMARKS**

Claim 28 has been amended to recite that the temperature is 5°C to about 35°C. Support for this temperature range can be found throughout the specification, for example, at page 5, lines 5-9. Claim 26 has been amended to recite that the first sample is incubated in the acidic medium "for a length of time that causes death of or damage to the competitive microbes when they are later incubated in a growth medium." Support for this language can be found throughout the specification as filed, for example, at page 5, lines 3-5 and in the Examples. Applicant submits that no new matter has been added to the application.

In the Restriction Requirement mailed March 17, 2008, the Examiner has restricted the claims to one of the following inventions under 35 U.S.C. §121:

Group I, consisting of claims 1-42 drawn to a method to segregate pathogenic and nonpathogenic microbes and to enrich and detect a target pathogenic enterohemorrhagic, enteropathogenic or enterotoxigenic microorganism;

Group II, consisting of Claims 43-50 drawn to a kit to enrich and detect a microbe;

Group III, consisting of claims 51-55, drawn to another kit to detect bacteria;

Group IV, consisting of claims 56-61, drawn to a third A kit comprising packaging material, culture media, a first pH modifier, and a second pH modifier, wherein addition of the first pH modifier to the culture media produces an acidic medium and addition of the second pH modifier to the acidic medium produces a growth medium.

Applicant provisionally elects, with traverse, Group I (claims 1-42), and as species pathogenic *Escherichia coli*, enterohemorrhagic *Escherichia coli*, *Escherichia* as target microbe, pH range 2-4, nutritional supplement as selective agent, temperature range about 5°C to about 35°C, organic acid (acetic acid if further election required) and inorganic acid (HCl if further election required).

The Restriction Requirement is traversed on the basis that Restriction Requirements are optional in all cases (M.P.E.P. § 803). If the search and examination of an entire application can be made without serious burden, the Examiner must examine the

application on the merits, even though it includes claims to distinct or independent inventions. M.P.E.P. § 803. Applicant submits that a search of several groups together would not be burdensome.

If the Examiner does not withdraw or modify the Requirement for Restriction, Applicant respectfully requests that the Examiner consider the unelected claims after allowance of a generic claim relating to the elected claims. Applicant further reserves the right to reintroduce the unelected claims in one or more divisional applications at a later date.

Species Election

Applicants respectfully traverse the requirement for electing a type of *Escherichia coli*, type of pathogenic *Escherichia coli*, type of microbe, pH range, nutritional supplement as selective agent, temperature range, organic acid and inorganic acid. Applicant requests that, at a minimum, the Examiner reconsider the species elections, and at least examine *Shigella* with *Escherichia* as a target microbe and all organic and inorganic acids.

As provided by the MPEP, species may be related inventions and need not be subject to restriction. *See* MPEP § 806.04(b). In particular, where species are claimed under a common genus and are related, the question of restriction is determined by the practice applicable to election of species and the practice applicable to other types of restrictions. *See id.* Applicants also respectfully remind the Examiner that they are entitled to examination of a reasonable number of species, and that election of species is for the convenience of the Examiner in initiating the search.

Here, at least claim 1 is generic with regard to types of *Escherichia coli*, types of pathogenic *Escherichia coli*, types of target microbes, pH ranges, selective agents, temperature ranges, organic acids and inorganic acids. At least claims 2, 7 and 48 are also generic with respect to types of pathogenic *Escherichia coli*. At least claims 1, 5 and 47 are generic with respect to types of target microbes. At least claims 1 and 9 are also generic with respect to pH ranges. At least claim 17 is also generic with respect to selective media. At least claim 57 is also generic with respect to organic acids, and claim

RESPONSE TO RESTRICTION REQUIREMENT

Page 11

Serial No.: 10/539,765

Dkt: 1662.004US2

Filed: February 8, 2006

Title: METHODS AND COMPOSITIONS FOR SELECTIVELY ENRICHING MICROBES

59 is generic with respect to inorganic acids. These generic claims explicitly define how the claimed species are related. The Examiner is reminded that M.P.E.P. § 803.02 states that “if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not . . . require restriction. [S]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended . . . to the extent necessary to determine patentability of the Markush-type claim.” (Emphasis added.)

Here, the number of *Escherichia coli*, pathogenic *Escherichia coli*, type of target microbes, pH range, selective agent, temperature range, organic acid and inorganic acid, and especially the number of organic and inorganic acids are not very numerous. Moreover, if the Examiner will not examine all target microbes Applicant is simply requesting that two be examined: *Escherichia* and *Shigella*. Applicant submits that the burden on the Examiner to search several species, and especially all organic and inorganic acids, and both *Escherichia* and *Shigella*, would be minimal.

Therefore, Applicant requests reconsideration of the requirement for election of one species of *Escherichia coli*, one species of pathogenic *Escherichia coli*, one species of microbe, one species of pH, one species of selective agent, one species of temperature, one species of organic acid and one species of inorganic acid. If this request is denied, Applicant submits that additional species should be considered as required under M.P.E.P. § 803.02, if a prior art search of the elected species turns up no relevant prior art. Applicant also reserves the right to file divisional application(s) on the non-elected claims and/or species.

RESPONSE TO RESTRICTION REQUIREMENT

Page 12

Serial No.: 10/539,765

Dkt: 1662.004US2

Filed: February 8, 2006

Title: METHODS AND COMPOSITIONS FOR SELECTIVELY ENRICHING MICROBES

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (516) 795-6820 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

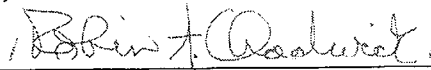
MICHAEL GRANT

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(516) 795-6820

Date April 17, 2008

By




Robin A. Chadwick
Reg. No. 36,477

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17th day of April 2008.

PATRICIA A. HULTMAN

Name


Signature